IN THE UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 96-2887

OASIS PUBLISHING CO., INC.,

Plaintiff-Appellant,

v.

WEST PUBLISHING CO.,

Defendant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

# BRIEF FOR AMICUS CURIAE UNITED STATES OF AMERICA IN SUPPORT OF APPELLANT

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

**CASES** Page(s)

**STATUTES**



**OTHER MATERIALS**

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## STATEMENT OF INTEREST OF THE UNITED STATES

The United States has a substantial interest in the resolution of this appeal. It has numerous responsibilities related to the proper administration of the intellectual property laws. The standards for copyright protection embody a balance struck between protecting private ownership of expression as an incentive for creativity and enabling the free use of basic building blocks for future creativity. See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). The United States has an interest in properly maintaining the "delicate equilibrium," Computer Associates International v. Altai, Inc., 982 F.2d 693, 696 (2d Cir. 1992), Congress established through the copyright law.

The interest of the United States in ensuring the proper preservation of that balance also reflects the fact that it has primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition as a means to advance the public interest.

Moreover, the United States is itself a substantial purchaser of legal research materials of the kind at issue in this case.

Finally, the United States has recently taken actions relating to the issue discussed. On June 19, 1996, the United States, together with seven states, filed an antitrust suit challenging the acquisition of West Publishing Co. by The Thomson Corp., together with a proposed settlement of that suit. Part of that settlement requires Thomson to license to other law publishers the right to star paginate to West's National Reporter System. United States v. The Thomson Corp., No. 96-1415 (D.D.C. filed June 19, 1996), Proposed Final Judgment, 61 Fed. Reg. 35250, 35254 (July 5, 1996). In announcing the settlement, the U.S. Department of Justice stated:

> Today's settlement, with its open licensing requirement does not suggest . . . that the Department believes a license is required for use of such pagination. The Department expressly reserves the right to assert its views concerning the extent, validity, or significance of any intellectual property right claimed by the companies [West and Thomson]. The Department also said that the parties agree that the settlement shall have no impact whatsoever on any adjudication concerning such matters.

U.S. Dept. of Justice, Press Release No. 96-287, at 3-4, 1996 WL 337211 (DOJ) *2 (June 19, 1996). The United States expressed these views in a Memorandum filed as amicus curiae last month in Matthew Bender & Company v. West Publishing Co., No. 94 CIV 0589 (S.D.N.Y.). This brief again expresses these views.

## STATEMENT OF ISSUES

Whether star pagination to a compilation of reported cases, without more, copies the arrangement of that compilation or otherwise infringes any copyright interest in that arrangement.

Apposite Cases and Statutory Provisions: Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 349 (1990); West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986) ("Mead"), cert. denied, 479 U.S. 1070 (1987); 17 U.S.C. 101; 17 U.S.C. 103(b).

## STATEMENT OF THE CASE

1. West Publishing Company ("West") publishes federal and state case reports in its National Reporter System. Since 1887, West has published state appellate decisions for four southern states, including Florida, in the Southern Reporter volumes of the National Reporter System. West also publishes Florida Cases, which, volume by volume, reprints all of the Florida case reports "as they appear in the Southern Reporter," complete with Southern Reporter volume and page numbers. (Memorandum and Order ("Op.") 2 (May 17, 1996).) West registers copyrights on the volumes of the Southern Reporter.

Oasis Publishing Company ("Oasis") publishes legal materials in electronic Compact Disk Read Only Memory ("CD-ROM") format. It proposes to (a) publish reports of Florida appellate cases in CD-ROM format,[1] (b) include citations to the location of each case in West's volumes ("parallel citation"), and (c) indicate the location of page breaks as they appear within cases in West's volumes ("star pagination"). Before carrying out its plans, Oasis sued for, among other things, a declaratory judgment "that West has no federal copyright protection to page numbers in the Southern Reporter[ and] that Oasis does not infringe any copyright in West by referring to the page numbers." (Op. 5.)[2] The parties cross-moved for partial summary judgment on these issues.

2. Relying on West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986) ("Mead"), cert. denied, 479 U.S. 1070 (1987), this Court's decision affirming the grant of a preliminary injunction to West blocking Mead's proposed star pagination, the district court denied Oasis's motion, granted West's, and dismissed two counts of the complaint. The court concluded that West had a protectible copyright interest in the arrangement of decisions in the Southern Reporter; that "[p]agination of that arrangement is an integral part of the arrangement and shares in any copyright protection in the arrangement itself" (Op. 15); that Oasis's star

[1]Oasis intends to obtain the text of Florida decisions from Florida Cases. (Op. 4.) This aspect of Oasis's plans played no role in the decision below and is not before this Court now.

[2]Oasis's complaint also alleged antitrust violations and state law claims, which we do not address.

pagination would infringe West's copyright in the arrangement of cases; and that star pagination was not a fair use of West's protected material within the meaning of the Copyright Act, 17 U.S.C. 107.

## SUMMARY OF ARGUMENT

As the Supreme Court emphasized in Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 349 (1990), "the copyright in a factual compilation is thin." Facts, which are not the product of the compiler's authorship, are not protected by the compilation copyright; nor is the effort involved in collecting the facts. Any copyright interest is limited to the compiler's original contribution -- the selection and arrangement of the facts. A competing work does not infringe, even if the unprotected facts it contains are copied directly from the copyrighted work, so long as it "does not feature the same selection and arrangement." Ibid.

Oasis's proposed star pagination would not involve copying West's arrangement of cases, for Oasis proposes simply to arrange its case reports in random or chronological order. But only the copying of arrangement is at issue here. Therefore, the star pagination would not infringe any relevant West copyright interest, even assuming that West's arrangement is sufficiently original to qualify for copyright protection.

The district court's contrary conclusion was apparently based on this Court's pre-Feist decision in Mead that including star pagination in Lexis would infringe. But the panel in Mead relied on the argument that star pagination might result in users not purchasing West's product, thus depriving West of the economic rewards of its efforts in compiling the reports. This reasoning cannot be reconciled with the Supreme Court's rejection of the "sweat of the brow" doctrine in Feist. Accordingly, Mead is no longer controlling law.

It is true that a star paginated compilation would provide the user with information about West's arrangement, and indeed might enable a user to arrange the case reports in the same way that West does -- at least in the sense of placing the reports in the same order and inserting page breaks at the same points. But describing an arrangement is not the same thing as copying an

arrangement. Whether or not a third party might use descriptive information to reproduce West's arrangement of the cases, Oasis's proposed work would not reproduce West's arrangement of the cases. Under Feist, therefore, Oasis's proposed star pagination would not infringe any West copyright interest in its arrangement.

## ARGUMENT

### I. The Copyright On A Compilation Is Thin, Protecting Only Those Components Of The Work That Are Original To The Author And Only Against Copying Of Those Components

In Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1990), which concerned copying from a telephone directory, the Supreme Court held that copyright protection for factual compilations extends only to the compiler's original contributions, and not to the facts themselves, despite the effort involved in compiling them. In so doing, the Court recognized the tension between the principle that facts are not protected by copyright and the principle that compilations of facts[3] generally are protected. Id. at 344-45.[4] It also recognized the tension between the means of "assur[ing] authors the right to their original expression" and the end of "encourag[ing] others to build freely upon the ideas and information conveyed by a work." Id. at 349-50. The Court resolved those tensions by emphasizing that "the copyright in a factual compilation is thin." The facts themselves are not protected because they are not the product of an act of authorship. Id. at 349.[5]

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[3]A compilation is defined as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. 101.

[4]The Copyright Act provides that "[t]he copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material." 17 U.S.C. 103(b).

[5]Although judicial opinions may not be "facts," they are, like facts, not the product of the compiler's authorship. There is thus no basis for treating compilations of judicial opinions differently under copyright law.

As the Court explained, "copyright protection may extend only to those components of a work that are original to the author," id. at 348, where the concept of originality encompasses both independent creation and "a modicum of creativity." Id. at 346. If the words expressing facts are original, they are protected; another author may copy the facts, but not the precise words. Id. at 348. But if "the facts speak for themselves," protectible expression exists, if at all, only in "the manner in which the compiler has selected and arranged the facts," and then only the original selection and arrangement are protected. Id. at 349. Because such a copyright is thin, copying from the copyrighted work is not infringement "so long as the competing work does not feature the same selection and arrangement." Ibid.

This holding has economic bite. The value of a factual compilation may lie less in the compiler's selection and arrangement of the facts than in the industriousness required to compile them, and the thinness of the copyright may permit others to appropriate that value. The Court acknowledged that, at first blush, such appropriation "may seem unfair," ibid., but it explained that in reality "[t]his result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." Id. at 350.[6]

Feist repudiated a body of case law that had relied on the so-called "sweat-of-the-brow" theory to provide broad copyright protection for factual compilations, thus protecting the fruits of

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[6]Copyright is not the only conceivable legal regime for protecting the fruits of industrious collection. The Delegation of the United States of America recently proposed to the World Intellectual Property Organization an international treaty that would provide to the "maker" of certain databases the exclusive right to extract all or a substantial part of the contents, without regard to copyrightability. World Intellectual Property Organization, Preparatory Committee of the Proposed Diplomatic Conference (December 1966) on Certain Copyright and Neighboring Rights Questions, Proposal of the United States of America on Sui Generis Protection of Databases, CRNR/PM/7 (May 20, 1996). Legislation providing such protection has been introduced in Congress. See H.R. 3531, 104th Cong., 2d Sess. (1996). The Supreme Court long ago held that the common law of unfair competition or misappropriation protected uncopyrighted news reports, International News Service v. Associated Press, 248 U.S. 215, 239-40 (1918), although the preemption provision of the Copyright Act, 17 U.S.C. 301, may limit such protection to the case of systematic appropriation of "hot" news, Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204, 208-09 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987); see also National Basketball Assoc. v. Sports Team Analysis and Tracking Systems, Inc., 1996 WL 444278 at *23-26 (S.D.N.Y.). Trade secret law may also provide some protection in appropriate circumstances. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974).

mere industrious collection. The Court specifically rejected Leon v. Pacific Telephone & Telegraph Co., 91 F.2d 484 (9th Cir. 1937), and Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922), because these cases "extended copyright protection in a compilation beyond selection and arrangement -- the compiler's original contributions -- to the facts themselves." 499 U.S. at 352-53. This Court's own analysis of the copyrightability of telephone directories, Hutchinson Telephone Co. v. Fronteer Directory Co., 770 F.2d 128, 130-31 (8th Cir. 1985), explicitly relied on Leon and Jeweler's Circular. Mead, in turn, relied on Hutchinson. See 799 F.2d at 1223, 1228. Thus, Feist represents a significant change in the law, requiring that the Mead panel's provisional, see 799 F.2d at 1227, 1229, conclusions regarding star pagination be reconsidered under the controlling standard of law -- whether Oasis's arrangement of cases, with the proposed star pagination, will be a copy of West's arrangement.[7]

## II. The Arrangement of Oasis's Proposed Compilation of Cases Is Not A Copy Of The Arrangement Of West's Compilation Of Cases

### A. Oasis's Proposed Arrangement Does Not Mimic West's Arrangement

No one contends that Oasis's proposed CD-ROMs will actually "feature the same . . . arrangement," Feist, 499 U.S. at 349, of cases as West's Southern Reporter. There is not even any suggestion that the cases will be placed in the same order. To the contrary, the record indicates that West's arrangement and the proposed Oasis arrangement will differ substantially. That is sufficient to establish that the proposed Oasis arrangement will not be a copy of West's arrangement.

Courts routinely analyze whether an arrangement protected by copyright has been impermissibly copied by comparing the ordering of material in the accused work with the ordering of material in the allegedly infringed compilation. See, e.g., Lipton v Nature Co., 71

[7]Feist also addressed whether the alphabetical arrangement of a telephone book involved the "quantum of creativity" necessary for copyright protection. 499 U.S. at 363-64. It therefore speaks to whether West's arrangement of cases exhibits the necessary quantum of creativity to permit copyright protection. But it is not necessary to resolve that question to decide this case.

F.3d 464, 470, 472 (2d Cir. 1995) (plaintiff's arrangement of terms of venery protectible; defendant's arrangement of 72 of these terms is "so strikingly similar as to preclude an inference of independent creation" when 20 of first 25 terms are duplicated and listed in same order, and in four other places four or more terms appear in the same order); Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 414 (7th Cir. 1992) (office supply catalog not infringed as compilation when it was not contended that defendant copied "the order of products or other typical features of a compilation"); Key Publications v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509, 515 (2d Cir. 1991) (no infringement when arrangement of categories in business directory is protectible, but facial examination reveals great dissimilarity between arrangement in copyrighted directory and in allegedly infringing directory); Worth v. Selchow & Righter Co., 827 F.2d 569, 573 (9th Cir. 1987) (alphabetical arrangement of factual entries in trivia encyclopedia not copied when trivia game organizes factual entries by subject matter and by random arrangement on game card).

Such a comparison here would show no copying. West's arrangement of Florida cases in general first separates cases by court level, then places the "fully headnoted opinions and jacketed memoranda" (arranged chronologically), before "sheet memoranda," which in turn precede "table dispositions" (arranged alphabetically); West also makes exceptions to these general principles. (Op. 15.) Oasis, in contrast, stated that it would "arrange its case reports in random or chronological order." (Corrected Memorandum of Law in Support of Its Motion for Final Summary Judgment 11 (citing Abrahams Aff. ¶ 5).) West apparently did not contest this statement. Of course, infringement does not require exact identity of arrangement, but only substantial similarity of expression. United Telephone Co. of Mo. v. Johnson Publishing Co., 855 F.2d 604, 608 (8th Cir. 1988). But we submit there is no basis in the record for concluding

that an "ordinary observer," id. at 609, would find West's and Oasis's arrangements to be substantially similar.[8]

The district court did not hold otherwise, apparently resting its finding of infringement on quite different concepts drawn from Mead. Its brief discussion of "Infringement by Star Pagination" simply does not address the controlling question -- whether Oasis's proposed CD-ROMs will actually "feature the same . . . arrangement," Feist, 499 U.S. at 349, of cases as West's Southern Reporter.

### B. The Mead Panel's Conclusion That Star Pagination Copies West's Arrangement Rested on the "Sweat of the Brow" Theory Subsequently Rejected in Feist

In Mead, a divided panel of this Court, ruling before Feist, concluded that star pagination to West's volumes impermissibly copied West's arrangement of cases, even though the allegedly infringing work and West's were not similarly arranged. But its approach rests on the discredited "sweat-of-the-brow" theory of compilation copyright and cannot be reconciled with Feist.

West alleged in Mead that "the LEXIS Star Pagination Feature is an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Act of 1976." 799 F.2d at 1222. The district court, in granting West a preliminary injunction, recognized that the arrangement of cases in the Lexis database differed significantly from the West arrangement. Faced with the argument that the Lexis "star pagination will not infringe West's arrangement because its random generated arrangement is entirely different from West's arrangement . . .[and] star pagination will not bring the arrangements closer together," West Publishing Co. v. Mead Data Central, Inc., 616 F. Supp. 1571, 1579-80 (D. Minn. 1985), aff'd, 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987), the district court held that "for infringement purposes,

[8]If Oasis arranges cases in chronological order, there will be some similarity between West's arrangement and Oasis's, because West's arrangement is in part chronological. But this provides no basis for concluding that one arrangement is copied from the other, since it shows only that chronology influenced both. Moreover, within cases some similarity of arrangement will result because both West and Oasis naturally arrange the words in more or less the same order the authoring court originally used. This too provides no basis for concluding that West's arrangement has been copied.

[Mead] need not physically arrange it's [sic] opinions within its computer bank in order to reproduce West's protected arrangements." 616 F. Supp. at 1580. That is, it did not matter that Mead's work did not "feature the same . . . arrangement," Feist, 499 U.S. at 349, as West's. Rather, the court concluded "that [Mead] will reproduce West's copyrighted arrangement by systematically inserting the pagination of West's reporters into the LEXIS database. LEXIS users will have full computer access to West's copyrighted arrangement." 616 F. Supp. at 1580.

The only support or explanation that the district court in Mead offered for its conclusion that Lexis could copy West's arrangement without arranging its cases as West did was a quotation from Rand McNally & Co. v. Fleet Management Systems, Inc., 600 F. Supp. 933, 941 (N.D. Ill. 1984): "'[D]atabases are simply automated compilations -- collections of information capable of being retrieved in various forms by an appropriate search program[.] . . . [I]t is often senseless to seek in them a specific fixed arrangement of data.'" 616 F. Supp. at 1580.[9] Rand McNally, however, rests entirely on the theory Feist rejected: "the basis for compilation protection is the protection of the compiler's efforts in collecting the data." 600 F. Supp. at 941. While the Feist Court thought selection and arrangement were the only protectible elements in the typical factual compilation, the Rand McNally court saw little significance to arrangement, relying on Professor Denicola: "'The creativity or effort that engages the machinery of copyright, the effort that elicits judicial concern with unjust enrichment and disincentive, lies not in the arranging, but in the compiling. . . . The arrangement formulation . . . is dangerously limited. At face value the

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[9]Rand McNally in turn was quoting Professor Denicola. Rand McNally also supported its denigration of arrangement as the basis of protection for factual compilation by citing National Business Lists v. Dun & Bradstreet, Inc., 552 F. Supp. 89 (N.D. Ill. 1982), which expresses the view that because computers store information "without arrangement . . .[,] an emphasis upon arrangement and form in compilation protection becomes even more meaningless than in the past." 552 F. Supp. at 97.

If it were true that data in an electronic database necessarily lacked arrangement, it would seem to follow that an electronic database simply could not infringe the copyright-protected interest in the arrangement of a compilation. Under Feist, the impossibility of copying the arrangement does not allow one to prove infringement without proof of copying. We doubt that it is true, however, since data lacking any arrangement at all would be difficult to use.

rationale indicates that the entire substance of a compilation can be pirated as long as the arrangement of data is not substantially copied.'" 600 F. Supp. at 941 (emphasis added) (quoting Robert C. Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 Colum. L. Rev. 516, 528 (1981)). However limited, the "arrangement" formulation is the Supreme Court's. Specifically referring to the very same article by Professor Denicola, the Feist Court wrote, "[e]ven those scholars who believe that 'industrious collection' should be rewarded seem to recognize that this is beyond the scope of existing copyright law." 499 U.S. at 360.

This Court affirmed the grant of a preliminary injunction in Mead, without questioning the district court's recognition that the Lexis arrangement of cases differed significantly from West's. It asserted that Mead's proposed star pagination would infringe West's copyright in the arrangement because, in combination with another feature of Lexis, it would permit Lexis users "to view the arrangement of cases in every volume of West's National Reporter System," 799 F.2d at 1227, but it emphasized that it would have found infringement even if that had not been the case. It is enough, the Court explained, that star pagination communicates to users "the location in West's arrangement of specific portions of text," with the result that "consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position." Id. at 1228.

Thus, the Court did not explain why communicating location -- that is, describing West's arrangement -- is the same thing as copying West's arrangement. Rather, the Court leapt directly from the fact of the communication to the economic consequence of that communication. In its

view, the vice of unauthorized star pagination is that it permits unfair appropriation of the fruits of industrious collection.[10]

Feist, however, makes clear that, as a matter of copyright law, this appropriation is not unfair, and that this test is not the proper test of infringement. See page 7 supra. Assuming the copying of protected arrangement, the resulting impact on West's market position would properly be considered in addressing a fair use defense to infringement. See 17 U.S.C. 107(4) (fair use analysis to consider "the effect of the use upon the potential market for or value of the copyrighted work"). But under Feist it plays no role in a determination of whether protected arrangement has been copied.[11]

### C. Describing West's Arrangement Without Reproducing It Does Not Constitute Copying of the Arrangement

As the Mead panel observed, star pagination communicates to users "the location in West's arrangement of specific portions of text." 799 F.2d at 1228. A compilation copyright, however, protects original components of the compilation against copying; it does not protect even original components against description. Indeed, virtually any index, any topical or other table of contents, any concordance, or any other finding aid would communicate information about

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[10]Similarly, in responding to the argument that star pagination does not infringe because citations to West page numbers are merely statements of fact, the Court focused on West's effort in collecting facts rather than any copying of original elements: "The names, addresses, and phone numbers in a telephone directory are 'facts'; though isolated use of these facts is not copyright infringement, copying each and every listing is an infringement," 799 F.2d at 1228, citing Hutchinson Telephone Co. v. Fronteer Directory Co., 770 F.2d 128 (8th Cir. 1985). Hutchinson adopts precisely the view of copyright rejected in Feist; it even relies on Leon and Jeweler's Circular, 770 F.2d at 130-31, two cases specifically rejected in Feist. See page 8 supra.

[11]In its infringement analysis, the Court quoted the Senate Report on the Copyright Act of 1976, as quoted in Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 568 (1985): "'[A] use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement.'" 799 F.2d at 1228. Harper & Row, however, involved admittedly verbatim copying of protected expression, 471 U.S. at 548-49, and the issue was fair use.

West's arrangement.[12] But surely that does not mean that all such finding aids would copy West's arrangement, even though they might be said to describe it.

West contends that the combination of the detailed information provided by star pagination with the text of the case reports renders Oasis's proposed product a copy of the West arrangement. It is true, of course, that a star-paginated collection of case reports might have a more substantial economic impact on West than other types of finding aids because users might regard it as a substitute for West's product. Indeed, a user could use the information provided by the star pagination to rearrange the case reports provided by Oasis into a compilation arranged in the same manner as West's reports.

Under Feist, however, the economic impact on the demand for West's compilation cannot justify a finding of infringement if Oasis has not copied an original element of West's arrangement. Nor can the possibility that a third party might use the information about West's arrangement provided by the star pagination to copy West's arrangement justify such a finding. Although users' actions may lead to vicarious liability for infringement or liability for contributory infringement under certain circumstances, neither can be found if the party alleged to be liable lacks the right to control the conduct of the individual who actually performs the infringement, Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 437 (1984), and the work has substantial noninfringing uses, id. at 442. Neither form of liability can be established with respect to the Oasis CD-ROMs. Neither the detailed nature of the information provided by the star pagination nor the combination of star pagination with a compilation of unprotected case

[12]Few cases address infringement by indexing. In New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217 (D.N.J. 1977), the district court denied a preliminary injunction against publication of a personal name index to the New York Times Index. Although the court determined the likelihood of success in light of fair use factors, it noted that the "personal name index differs substantially from the Times Index, in form, arrangement, and function," id. at 226 (emphasis added), even though it communicated the locations in the Times Index at which particular personal names could be found. The court greeted with incredulity the plaintiff's argument "that a copyrighted work cannot be indexed without permission of the holders of the copyright to the original work." Id. at 224-25. See also Kipling v. G.P. Putnam's Sons, 120 F. 631, 635 (2d Cir. 1903) (defendants "were at liberty to make and publish an index" of copyrighted material).

reports, arranged in a different manner than West's reports, can suffice to render Oasis's proposed product a copy of West's arrangement.

West has asserted in other litigation that the definition of "copies" in the Copyright Act, 17 U.S.C. 101, justifies treating star-paginated compilations as copies of its arrangement, even if the case reports are arranged differently, because the user could recreate West's arrangement. See, e.g., West Publishing Company's Memorandum of Law in Opposition to Plaintiff Matthew Bender & Company's Motion for Summary Judgment 7-10, Matthew Bender & Company v. West Publishing Co., No. 94 CIV 0589 (S.D.N.Y. 1996). The statute provides (emphasis added):

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

This definition does not support West's argument. On its face, the definition deals with the fixation of the copyrighted work in a material object, not the fixation of a different work from which the copyrighted work may be recreated; West's argument begs the question whether Oasis's proposed CD-ROM is a fixation of West's work. The legislative history makes clear that the clause beginning with "and" was intended to deal with the problem of works fixed in media not designed to be read by humans.[13] It has nothing to do with the question whether a compilation not arranged like West's nevertheless copies West's protected arrangement.

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[13]The clause serves "to avoid the artificial and largely unjustified distinctions, derived from cases such as White-Smith Publishing Co. v. Apollo Co., 209 U.S. 1 (1908)." S. Rep. No. 473, 94th Cong., 1st Sess., at 51 (1975); H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 52 (1976), reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5665, quoted in Williams Electronics, Inc. v. Arctic Intern., Inc., 685 F.2d 870, 877 n.8 (3d Cir. 1982). White-Smith held that a piano roll version of copyrighted sheet music did not infringe because the perforations in the piano roll were not a form of notation intelligible to the ordinary human eye and thus did not copy the sheet music, 209 U.S. at 17-18, even though the position and size of the perforations correspond to the order of the notes in the copyrighted composition. Id. at 10. The Court rejected the contention that copyright protection of the day "cover[ed] all means of expression of the order of notes which produce the air or melody which the composer has invented." Id. at 11. If that were still the law, a CD-ROM could not possibly infringe the copyright on a printed book, even if the CD-ROM contained digitized images of every page in the book, arranged in the same sequence as in the book.

Acceptance of West's argument that including information that would allow a third party to recreate West's arrangement in a compilation of unprotected case reports arranged differently constitutes copying West's arrangement would have far-reaching consequences. Indeed, if the ordering of a copyrighted compilation of unprotected facts were based on the facts in that compilation, under West's rationale it would seem to be infringement to obtain those facts from another source and publish them in a different order.[14] To escape a claim that it copied the first compilation's arrangement, the second compilation would presumably have to leave out facts found in the first compilation, lest it allow third parties to recreate the arrangement of the first compilation.

A hypothetical example may clarify the implications of West's position. Suppose a firm obtains from the 1990 Census of the United States data concerning every county in the United States and publishes a compilation of those data, listing the counties in descending order of one of the included data elements, the proportion of the population consisting of males of ages 18 through 40. Suppose further that this arrangement, which may meet the Feist test of originality[15]

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[14]Some compilations are arranged in orders not based on the data found in the compilation. In Lipton, for example, the compilation was arranged according to the compiler's esthetic judgments. 71 F.3d at 470. The copyright on a volume of Shakespeare's sonnets, all in the public domain, arranged in order of the editor's judgment of esthetic merit would, we assume, protect that original arrangement. Another editor could, without infringing the copyright, copy the sonnets from that volume and publish them in a different arrangement. But as we understand West's principle, it would become infringement if the editor of the second volume were to include an appendix that merely tells the reader the order in which the sonnets appear in the first volume. Suppose that two prior compilers had each published the sonnets in order of their separate, and different, estimates of esthetic merit. Under West's principle, it would apparently infringe the copyrights on both prior volumes to publish the sonnets in still a different order while including two appendices, each telling the reader the order in which one of the prior volumes had published the sonnets.

[15]Post-Feist case law does not resolve whether the arrangement of a compilation is protected by copyright if that arrangement is pursuant to a mechanically applied criterion, but the choice of that criterion is creative. Feist, however, implies that such an arrangement is protected. Alphabetical ordering is mechanical in application, yet the Supreme Court, in holding that the alphabetical ordering of a telephone directory was not protected, thought it necessary to explain that the choice of alphabetical ordering for a telephone directory "is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. . . . It is not only unoriginal, it is practically inevitable [and therefore] does not possess the minimal

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and which may interest those marketing products to adult males, is protected by the firm's copyright on the compilation. Under Feist, another firm may copy all the data from the first firm's compilation, while arranging its compilation alphabetically by state and county. It may do so because even though the arrangement of the first compilation is protected by copyright, the data themselves are not, and the second compilation does not "feature the same . . . arrangement," Feist, 499 U.S. at 349, as the first. But the second compilation contains all the information a user needs to recreate the arrangement of the first, and so under West's interpretation of the copying of an arrangement, creation of the second compilation would infringe the copyright on the first.[16] West's position therefore protects the facts themselves in many circumstances where Feist would leave them unprotected.

This case, like Mead before it, arose primarily because new technologies, new means of managing information, became available, a frequent event in the information age. We have seen, in on-line computer searchable databases and in CD-ROM products, new ways of working with the raw materials of legal research -- case reports, statutes, and other materials that once appeared only in print form. Neither we nor this Court can predict what new technological developments will next year or in the next decade further revolutionize the practice of law and make the substance of law more readily available to all. By making clear the limited scope of copyright protection for factual compilations, Feist cleared the way for these creative developments. It should be followed here.

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(...continued)
creative spark required by the Copyright Act." 499 U.S. at 363.

[16]To avoid infringing under West's principle, the publisher of the second compilation would have to omit the data concerning the proportion of the population consisting of males of ages 18 through 40, even though Feist would allow copying those data. And there would be no infringement even under West's principle if the first compilation arranged the counties in order of the first publisher's assessment of the moral worthiness of the county's population, and the second publisher listed the counties in a different order.

## CONCLUSION

This Court should reverse the judgment below and remand for further proceedings.

Respectfully submitted.

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CERTIFICATE OF SERVICE

I certify that, on this 9th day of September, 1996, I caused two copies of the foregoing BRIEF FOR AMICUS CURIAE UNITED STATES OF AMERICA IN SUPPORT OF APPELLANT to be served by Federal Express on:

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